

REMARKS

Claims 1, 3-12, 14-8 and 20 are pending. The applicant is submitting this Response under 37 C.F.R. §1.116 in order to urge the Examiner to withdraw the rejection and to correct a typographical error in claim 1. Entry of the proposed amendment to claims 1 is respectfully requested.

In the office action that was mailed July 20, 2007, each of the claims was rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. pre-grant publication 2001/0044805 by Multer in view of U.S. pre-grant publication number 2002/0116404 by Cha et al. The Examiner's rejections of claims 1, 3-12, 14-8 and 20 was based on the Examiner's determination that each and every limitation, of each and every claim, can be found in the combination of *Multer* and *Cha*.

The claim rejections were improper and must be withdrawn for at least three reasons.

First, it was improper for the Examiner to have combined *Multer* and *Cha* because the references cannot be combined without render one or both of them inoperative for their intended purposes and/or without substantially revising one or both of them (See Section I below). Second, *Multer* and *Cha* do not disclose each and every pending claim limitation (See Section II below). Third, neither *Multer* nor *Cha* enable limitations of the pending claims for which they were cited (See Section III below). Since they do not enable the limitations that they allegedly disclose, they do not qualify as valid prior art. They cannot be cited as rendering the pending claims obvious.

I. It was improper for the Examiner to have combined *Multer* and *Cha*.

In the recent decision of *KSR v. Teleflex*, the U.S. Supreme Court discussed the Federal Circuit's teaching, suggestion, motivation (TSM) obviousness test but the Court essentially held that obviousness under §103 should be determined under the test set that the Court out in *Graham v. Deere*. As the Examiner presumably knows, obviousness under *Deere* is determined by a consideration of the scope and content of the prior art; differences between the prior art and the claims at issue; and the level of ordinary skill in the pertinent art.

The plain language of 35 U.C.C. §103 states that obviousness depends on whether claimed subject matter, "as a whole" would have been obvious at the time of its invention. *KSR*

did not overturn *other* Federal Circuit case law, which holds that the differences between a claimed invention and the prior art are not to be determined based on whether individual differences themselves would have been obvious but rather whether a claimed invention as a whole would have been obvious.¹ Still other case law holds that the *prior art references* must also be considered as a whole.² Stated another way, it is improper for an Examiner to pick and choose snippets of different references to support an entirely conclusory rejection under §103, as the Examiner did in this case.

In *KSR*, the Court said that “a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” Obviousness must be determined by a consideration of the prior art “as a whole” as well as a consideration of the claimed invention, “as a whole.”

Federal Circuit case law still holds that when obviousness is based on a combination of references, there must be “reasonable expectation” of the combined references’ success in achieving the claimed result and that the combined references must also disclose each and every pending claim limitation³ The teachings of combined references also cannot render a pending claim obvious if a proposed modification to a reference in order to combine them would render a prior art reference unsatisfactory for its intended purpose⁴ nor can combined references render claims obvious if a proposed modification to a combined reference would change a principle of operation of the prior art reference being modified.⁵

With the foregoing in mind, it was improper for the Examiner to have combined *Multer* with *Cha* because when those two references are each considered, “as a whole,” the modification of *Multer* by *Cha* renders *Multer* unsatisfactory for its intended purpose. Their combination would also require a significant change in the principle of operation of *Multer*.

1 35 U.S.C. §103(a). See also MPEP §2141.02, subsection I, citing *Stratoflex, Inc. v. Aeroquip Corp.* 713 F.2d 1530 (Fed. Cir. 1983).

2 See MPEP §2141.03, subsection VI, citing *W.L. Gore v. Garlock, Inc.* 721 F.2d 1540 (Fed. Cir. 1983).

3 See MPEP §2143, citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See also MPEP §2143.02 citing *In re Merck Co.* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

4 See MPEP §2143.01, subsection V, citing *In re Gordon*, 733 F.2d 900 (Fed Cir. 1984).

5 See MPEP §2143.01, subsection VI, citing *In re Ratti*, 270 F.2d 810 (Fed. Cir. 1959).

It is an indisputable fact that *Multer* discloses and claims a method and apparatus for synchronizing data between different types of devices, each of which can have different data base structures. By way of example, paragraph [0006] of *Multer* lists several different types of devices and notes that each of them can have its own data that might need to be synchronized with other devices. In paragraphs [0009] and [0010], *Multer* states that in the prior art, data fields from one application needed to be mapped to data fields in another application. In paragraphs [0015] and [0016], *Multer* discusses problems that arise in the synchronization of disparate databases. In the Detailed Description of *Multer*, paragraphs [0039]-[0040], [0042] and [0045] make it clear that *Multer* is directed to the synchronization of different types of databases.

Referring now to *Cha*, paragraph [0013] of *Cha* suggests that the databases of concern to *Cha* are huge. Paragraph [0016], and others, make it clear that *Cha* pertains to the synchronization of different versions of the same database.

In paragraphs [0034]-[0036], *Cha* describes how different versions of the same database can be quickly and efficiently synchronized. In paragraph [0036], *Cha* states that the databases are synchronized by using a “bit-wise exclusive-OR (XOR) result of the data image of the database before update (“before image”) and the data image of the database after update (“after image”).

When *Cha* is considered as a whole, and specifically including paragraph [0036], *Cha* requires that each and every bit, of two different versions of the same database be exclusive OR-ed and that the result of the bit-wise exclusive OR be used to update one of the database versions. When *Multer* and *Cha* are each considered as a whole there is no chance that their combination would work for their intended purposes nor would their combination accomplish the purpose for which the applicant’s invention is intended. To be more precise, the Examiner’s combination of *Cha* with *Multer* would require the disparate databases disclosed in *Multer* to be bit-wise exclusive OR-ed with each other, the result of which would be useless. Combining *Multer* and *Cha* as the Examiner did to find the claims obvious would render *Multer* unsatisfactory for its intended purpose and/or would require a complete change in the principle of operation of *Multer*. Under controlling Federal Circuit case law and under teachings of the

MPEP, it was improper for the Examiner to have found the pending claims obvious on the combination of *Multer* and *Cha* because it was improper for the Examiner to have combined them.

II. *Multer* and *Cha* do not disclose all of the pending claim limitations.

Even if the combination of *Multer* and *Cha* was not improper, their combination does not disclose each and every limitation of the pending independent claims, as Federal Circuit case law and the MPEP both require.

Claims 1 and 12 recite that the change list creator creates a change list that lists indicia of each change made to one of the databases during a selected time period. The claims also recite that a change list identifier is assigned to a change list and that the identifier “uniquely identifies the first change list from other change lists.”

Perhaps even more importantly, claims 1 and 12 both recite that the change list identification is “communicated over a radio air interface separately from the first change list.” Both claims thus also require that the “change list identifier” be sent, in addition to the actual change list being sent over a radio air interface.

Regarding the change list identifier, in the office action, the Examiner cited lines 1-6 of paragraph 35 of *Cha* as teaching the “change list identifier.” As for the radio communication of the change list identifier, the Examiner cited paragraph [0006] of *Multer* as ostensibly teaching that the change list identifier is sent over a radio air interface.

Both limitations are missing from *Multer* and *Cha*.

The change list identifier limitation recited in both claims 1 and 12 both require the change list identifier to uniquely identify *one change list from another*, which the claims also require to have been created at different times. The claims also require the change list identifier to be assigned after receipt of a signal indicating that databases are to be updated.

Lines 1-3 of paragraph [0035] of *Cha*, which the Examiner cited against the change list identifier limitation, mentions an “update log,” however, the *Cha* description of the “update log” is ambiguous at best because it is simply described as being a “record used to store changes in the database....” Lines 4-6 of paragraph [0035] state that a “log sequence number” or “LSN”

stores the identity of a “current log record by preferably storing the identity of the current log record on disk.”

A careful review of *Cha* reveals that neither the update log nor the log sequence number satisfy the change list identifier limitation of claims 1 and 12 because the update log and the log sequence number in *Cha* are made without regard to the time at which they were created. They are not capable of identifying other logs, they do not appear to have any sort of time stamp on them nor are they created after receipt of a signal indicating that a database update is to be performed.

As for the pending claims’ limitations that require the change list identification and the change list to be sent over a “radio air interface,” paragraph [0006] of *Multer*, which the Examiner cited, says only that many different types of devices can have data stored in them and that the data in the different types of devices might need to be synchronized. One of the devices listed in paragraph [0006] is a cell phone. Paragraph [0006] of *Multer* does not disclose the transmission of a change list or a change list identifier as claims 1 and 12 both require and the mere disclosure of a cell phone cannot be read as teaching the transmission of such data between databases in a cell phone and a cell phone network. The combination of *Multer* and *Cha* do not disclose each and every limitation of pending claims 1 and 12. The rejection was therefore improper.

III. *Multer* and *Cha* do not enable limitations they allegedly disclose.

As set forth above, Federal Circuit case law also holds that a prior art reference must also enable subject matter for which it is cited.⁶ Neither of them disclose any sort of radio device that is *capable* of effectuating the wireless data transfers required by claims 1 and 12. Stated alternatively, neither *Cha* nor *Multer* disclose any sort of circuit, device or method that is capable of a wireless data transfer, which the pending claims require. Under controlling Federal Circuit case law, neither of them can be relied upon as disclosing the transfer of both a change list identification and a change list via a “radio air interface” as both claims 1 and 12 require.

⁶ See e.g., Amgen v. Hoechst, 314 F.3d 1313, 1354 (Fed. Cir. 2003).

As was stated in the applicant's last response, *Multer* does not enable the change list lock. The Examiner cited *Multer*'s disclosure of "locking modules" as ostensibly disclosing the pending claims' change list lock, however, the "locking modules" mentioned in *Multer* could be hardware just as easily as they could be software that the pending claims require.

The Examiner's rejections were improper and must be withdrawn.

The Examiner's rejections were improper because the Examiner simply "cherry picked" phrases and terms from two references that no one of ordinary skill in art would have combined as the Examiner has done. The Examiner simply combined the phrases and terms without regard as to whether it made any sense to do so and then summarily concluded that their combination made the claims obvious. The Examiner's combination of *Multer* and *Cha* would also render one or both of them inoperative for their intended purposes. Thus, there is no reason why anyone of ordinary skill in the art would combine them.

Even if the references were properly combined, their combination does not satisfy each and every limitation of the pending independent claims. Moreover, the references do not enable the pending claim limitations that the Examiner has cited them as disclosing.

Unless the Examiner intends to ignore the MPEP and controlling Federal Circuit case law, the rejections must be withdrawn and the claims allowed to issue.

Respectfully submitted,

/ Robert H. Kelly /

Robert H. Kelly
Registration No. 33,922

SCHEEF & STONE, L.L.P.
5956 Sherry Lane, Suite 1400
Dallas, Texas 75225
Telephone: (214) 706-4201
Fax: (214) 706-4242
robert.kelly@scheefandstone.com